UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,768	11/30/2001	Hideo Suzuki	393032001901	2094

25224 7590 06/16/2004

MORRISON & FOERSTER, LLP
555 WEST FIFTH STREET
SUITE 3500
LOS ANGELES, CA 90013-1024

EXAMINER	
FLETCHER, MARLON T	

ART UNIT	PAPER NUMBER
2837	

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/008,768	SUZUKI ET AL.	
	Examiner	Art Unit	
	Marlon T Fletcher	2837	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 April 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14 and 16-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14 and 16-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/977,727.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *02/06/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on 02/08/2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Patent 6,452,082 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 14, 16, 17, and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Serra et al. (5,536,902).

As recited in claim 14, Serra et al. disclose a method of processing musical performance data, comprising the steps of: receiving via input (12) a sequence of pieces of musical performance data represented by a sequence of musical notes; designating via interface (15) a performance method for each of the received pieces of musical performance data by a player in real time; and forming musical tone data by attaching performance method data indicative of the designated performance method to said each of the received pieces of musical performance data (column 13, lines 39-51 and column 14, lines 51-60).

As recited in claim 16, Serra et al. disclose a method of forming musical tone waveform data, comprising the steps of: reproducing musical performance data (column 13, lines 29-33); generating performance method data indicative of a performance method as the reproduction of said musical performance data (column 13, lines 39-48); and forming musical tone waveform data based on said musical performance data and said performance method data (column 13, lines 48-51).

As recited in claims 17 and 24, Serra et al. disclose a method, wherein said generation of performance method data is carried out based on a performance method designated by a player in real time, and said formation of musical tone waveform data is carried out by attaching said performance method data to said musical performance data (column 9, lines 7-17 and column 14, lines 56-61).

As recited in claim 21, Serra et al. disclose a method of making a medium which stores data prepared using the steps of: analyzing (analysis 10) a progression manner of at least one note in musical performance data; decomposing said musical performance data into a plurality of pieces according to results of said analyzing (column 10, lines 3-56); determining a performance method for each of said plurality of pieces, which is to be applied in performing each of said. plurality of pieces (column 12, lines 29-54); providing a storage medium (100); and storing data representative of said determined performance method for each of said plurality of pieces in the storage medium (column 10, lines 57-60).

As recited in claim 22, Serra et al. disclose a method of making a medium which stores data prepared using the steps of: selecting tone color data for musical

performance data (column 8, lines 44-47); analyzing (10) at least one piece of said musical performance data in a manner corresponding to the selected tone color data; forming musical tone data by attaching performance method data indicative of a performance method corresponding to a result of said analyzing to said musical performance data (column 13, lines 39-51 and column 14, lines 51-60); providing a storage medium (100); and storing data representative of said formed musical tone data in the storage medium (column 10, lines 57-60).

As recited in claim 23, Serra et al. disclose a method of making a medium which stores data prepared using the steps of: reproducing musical performance data (column 13, lines 29-33); generating performance method data indicative of a performance method during the reproduction of said musical performance data (column 13, lines 39-48); forming musical tone waveform data based on said musical performance data and said performance method data (column 13, lines 48-51); providing a storage medium (100); and storing data representative of said formed musical tone waveform data in the storage medium (column 10, lines 57-60).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 18-20 and 25, are rejected under 35 U.S.C. 103(a) as being unpatentable over Serra et al. in view of Kellogg et al. (4,930,390) and Kakishita et al. (5,591,930).

As recited in claims 18 and 25, Serra et al. disclose a method of generating musical tones, comprising the steps of: selecting at least one tone color for a musical piece (column 8, lines 44-47); and generating musical tones in accordance with the selected performance method (column 13, lines 39-51).

As recited in claim 19, Serra et al. disclose a method, wherein said selection is made by a user (column 9, lines 21-33 and column 14, lines 51-60).

As recited in claim 20, Serra et al. disclose a method, wherein a desired performance method is selected from the displayed performance methods by using a switch (column 9, lines 21-26).

Serra et al. do not disclose displaying the performance method.

However, Kellogg et al. disclose displaying performance parameters to be selected for varying a performance (figures 7A & 7B). Kakishita et al. disclose methods to be selected corresponding to each of the selected tone colors on a display, wherein one of the displayed performance methods can be selected (figures 3, 4, & 9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the teachings of Kellogg et al. and Kakishita et al. with the apparatus of Serra et al., because enhancement is provided, wherein the selection of performance methods can be made from a visual display.

Response to Arguments

5. Applicant's arguments filed 04/02/2004 have been fully considered but they are not persuasive.

The applicants argue that Serra does not disclose the claimed invention. "The present invention is to a tone generating method .... The invention allows performance method codes to be assigned to performance information." The applicants further state that Serra merely analyzes data in time frames. However, the examiner's position is that the data represented by the time frames, is performance data. As stated in the rejection above, performance methods which allow the user to control the performance data, are selected by the user, wherein the performance data is provided in a sequence of pieces of a performance. As for the use of performance codes, this limitation is not recited in the claims. The performance methods of Serra as discussed above, include vibrato and tremolo. The applicants argued that Kellogg do not disclose displaying performance methods such as glissando, tremolo, etc. However, Serra provides performance methods such as glissando, tremolo, etc. In view of Kellogg, it would be obvious to provide a display of glissando, tremolo, etc. Further the claims do recite that the performance methods are one such as glissando, tremolo, etc. The claims are interpreted in the broadest manner possible. Based on the claimed subject matter, the examiner believes the above rejection meets the claim limitations.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marlon T Fletcher whose telephone number is 571-272-2063. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Martin can be reached on 571-272-2107. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306.

Marlon T Fletcher
Primary Examiner
Art Unit 2837

MTF
June 13, 2004